

### III. Remarks

Claims 1, 2 and 4-20 were previously pending.

Claims 2 and 15 have been canceled without prejudice or disclaimer.

Claims 1, 5-10, 12-14, 17 and 18 have been amended.

Claims 4, 11, 16, 19 and 20 have been maintained in their previously-presented form.

As a result, claims 1, 4-14 and 16-20 are pending.

Favorable consideration of claims 1, 4-14 and 16-20 is respectfully requested.

#### **SUMMARY OF ADVISORY ACTION MAILED NOVEMBER 26, 2008**

In the Advisory Action mailed November 26, 2008, the Examiner maintained the rejections set forth in the Final Office Action mailed August 7, 2008, namely:

- the rejection of claims 1, 2 and 4-18 under 35 U.S.C. §103(a) over U.S. Patent No. 6,491,823 to Safir et al. ("Safir '823") in view of each of U.S. Patent No. 5,702,950 to Tajima ("Tajima '950"), U.S. Patent No. 6,607,662 issued to Ikeda et al. ("Ikeda '662"), and Deschamps et al., *Rapid Purification of Recombinant Green Fluorescent Protein Using the Hydrophobic Properties of an HPLC Size-Exclusion Column*, Protein Expression and Purification 6, pp. 555-568 (1995) ("Deschamps"); and
- the rejection of claims 1, 2, 4, 5, 8 and 12-20 under 35 U.S.C. §103(a) over U.S. Patent No. 5,895,631 to Tajima ("Tajima '631").

#### **REJECTIONS UNDER 35 U.S.C. §103**

##### **Claims 1, 2 and 4-18**

As noted above, claims 1, 2 and 4-18 stand rejected under 35 U.S.C. §103(a) over Safir '823 in view of each of Tajima '950, Ikeda '662 and Deschamps. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

Amended claim 1 recites: A carrier housing/processing apparatus comprising;

one or a plurality of carriers fixed or able to be fixed with chemical substances such as ligands;

a transferable carrier housing section comprising:

a large diameter section which accommodates said carrier, and

a small diameter section connected to the large diameter section, the small diameter section comprising a tip, a fluid inlet/outlet at the tip, and a smaller diameter;

a plurality of containers provided outside of said transferable carrier housing section;

a drawing/discharging section configured to draw a fluid through said inlet/outlet and into said transferable carrier housing section, and then discharge the fluid out of said transferable carrier housing section through said inlet/outlet; and

a transferring section which transfers said transferable carrier housing section relatively with respect to the containers, the transfer of said transferable carrier housing section relatively with respect to the containers including the transfer of the large diameter section and the small diameter section relatively with respect to the containers, the transfer of the small diameter section relatively with respect to the containers including the transfer of the tip and the inlet/outlet relatively with respect to the containers,

wherein said carrier is formed in a size or a shape not allowing said carrier to pass through said inlet/outlet, and in a state of holding said carrier in said housing section, by self-weight of said carrier, frictional force between said carrier and the inner wall of said housing section, or remote force from outside with respect to said carrier, a fluid is drawn and discharged,

wherein said carrier housing section further comprises an opening having a size enabling said carrier to pass through, and said drawing/discharging section is provided with a nozzle which detachably connects with said opening, and said carrier is formed in a size capable of passing through said opening but not capable of passing through said inlet/outlet, and

wherein the smaller diameter of the small diameter section of said transferable carrier housing section enables insertion of the smaller diameter section into each of the containers, the insertion of the smaller diameter section into each of the containers including the insertion of the tip and the inlet/outlet into each of the containers.

The Examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 1 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Safir '823, Tajima '950, Ikeda '662 and Deschamps, alone or in any combination, do not disclose the subject matter of amended claim 1, as recited above.

**In the Advisory Action mailed November 26, 2008**, the Examiner asserted that the valve 100 of Safir '823 with its inlets and outlets is a "fluid inlet/outlet" in the context of claim 1, writing that:

the valve [100 of Safir '823] with its inlets and outlets is considered part of the carrier housing section and therefore, Safir et al. do teach drawing a fluid through the inlet/outlet into the carrier housing section and then discharging the fluid out of the carrier housing section through the same inlet/outlet.<sup>1</sup>

**Assuming for the purpose of argument that the valve 100 can rightly be characterized as the "fluid inlet/outlet" in the context of claim 1, Safir '823 still does not disclose that the fluid inlet/outlet is movable relative to the containers, and insertable into the containers, as required by amended claim 1.** Indeed, Figs. 2A, 2B, 6, 7A and 7B of Safir '823 clearly show that the valve 100 is not movable relative to, and insertable into, any of the sample containers formed in the sample tray 202 shown in Figs. 6, 7A and 7B.

Since the applied references do not disclose the subject matter of amended claim 1, a rejection of amended claim 1 under 35 U.S.C. §103(a) over the applied references is not applicable.

---

<sup>1</sup> Advisory Action mailed November 26, 2008, page 2, paragraph 2, lines 6-8.

Amended claim 14 includes a method version of the subject matter of amended claim 1 and therefore is allowable for at least the same reasons as noted above with respect to amended claim 1.

Claims 4-13 and 16-18 depend from and include the subject matter of amended claims 1 and 14, respectively, and therefore are allowable for at least the same reasons as noted above with respect to amended claims 1 and 14, respectively.

Claims 2 and 15 have been canceled without prejudice or disclaimer and therefore any rejection thereof is no longer applicable.

For the foregoing reasons, it is respectfully requested that the rejection of claims 1, 2 and 4-18 under 35 U.S.C. §103(a) over Safir '823 in view of each of Tajima '950, Ikeda '662 and Deschamps be withdrawn.

**Claims 1, 2, 4, 5, 8 and 12-20**

As noted above, claims 1, 2, 4, 5, 8 and 12-20 stand rejected under 35 U.S.C. §103(a) over Tajima '631. Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As noted above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Tajima '631 does not disclose the subject matter of amended claim 1, as recited above. More particularly, in the context of amended claim 1, Tajima '631 does not disclose an apparatus wherein a carrier is formed in a size or a shape not allowing said carrier to pass through said inlet/outlet. This lack of disclosure was confirmed by the Examiner,<sup>2</sup> who nevertheless asserted that this limitation is obvious in view of Tajima '631.<sup>3</sup>

In response to the Final Office Action mailed August 7, 2008, Applicant argued that the Examiner's proposed modification of Tajima '631 renders Tajima '631 unsatisfactory for its intended purpose.<sup>4</sup>

---

<sup>2</sup> Final Office Action mailed August 7, 2008, page 9, lines 12 and 13 ("Tajima et al. do not teach their magnetic particles having a size such that they are not capable to pass through the inlet/outlet.").

<sup>3</sup> *Id.* at page 9, lines 17-22.

<sup>4</sup> Response to Final Office Action mailed August 7, 2008, filed on October 7, 2008, pages 12 and 13.

**In the Advisory Action mailed November 26, 2008**, the Examiner asserted that:

[t]he intended purpose in Tajima is to separate the magnetic particles from the rest of the reaction fluid.<sup>5</sup>

Applicant agrees with the Examiner.

**Further, in the Advisory Action mailed November 26, 2008**, the Examiner asserted that:

[t]he suggested modification proposes that the particles are already within the cylindrical chip **and they have a size such that they are not able to pass through the inlet-outlet** outside of the cylindrical chip and into the remaining of the reaction fluid. Since the particles are already inside the chip, there is no need to draw them through the inlet-outlet. Such a modification would readily separate the magnetic particles from the remainder of the reaction fluid.<sup>6</sup> (Emphasis Added)

Applicant respectfully notes that the suggested "modification" renders Tajima '631 wholly unsatisfactory for its intended purpose.

In order to be satisfactory for its intended purpose, *namely separating the magnetic particles from the rest of the reaction fluid*, **Tajima '631 requires that the magnetic particles be able to pass through the inlet/outlet.**<sup>7</sup> The Examiner's suggested "modification" of Tajima '631, which requires that the magnetic particles not be able to pass through the inlet/outlet, clearly renders Tajima '631 unsatisfactory for its intended purpose.

Since a modification cannot render a reference unsatisfactory for its intended purpose,<sup>8</sup> a rejection of amended claim 1 under 35 U.S.C. §103(a) over Tajima '631 is inapplicable.

---

<sup>5</sup> Advisory Action mailed November 26, 2008, page 2, paragraph 6, line 1.

<sup>6</sup> *Id.* at page 2, paragraph 2, lines 6-8.

<sup>7</sup> See, e.g., Tajima '631, col. 17, line 36 through col. 18, line 2.

<sup>8</sup> MPEP §2143.01 (V) ("The proposed modification cannot render the prior art unsatisfactory for its intended purpose.").

It is further noted that the suggested "modification," which proposes that the magnetic particles are already within the cylinder chip and thus are already separated from the reaction fluid, renders the teaching of Tajima '631 useless or irrelevant, much less unsatisfactory for its intended purpose, because there is no longer a need to employ the teaching of Tajima '631 to separate the magnetic particles from the rest of the reaction fluid.

Claims 2 and 15 have been canceled without prejudice or disclaimer and therefore any rejection thereof is no longer applicable.

Claims 4, 5, 8, 12, 13 and 19 depend from and include the subject matter of claim 1, and therefore are allowable for at least the same reasons as noted above with respect to claim 1 and Tajima '631.

Amended claim 14 is a method version of amended claim 1 and therefore is allowable for at least the same reasons as noted above with respect to claim 1 and Tajima '631.

Claims 16-18 and 20 depend from and include the subject matter of claim 14, and therefore are allowable for at least the same reasons as noted above with respect to claim 14 and Tajima '631.

For the foregoing reasons, it is requested that the rejection of claims 1, 2, 4, 5, 8 and 12-20 under 35 U.S.C. §103(a) over Tajima '631 be withdrawn.

### Conclusion

It is believed that all matters set forth in the Final Office Action Mailed August 7, 2008, and the Advisory Action mailed November 26, 2008, have been addressed. Applicant has made a diligent effort to advance the prosecution of this application by canceling claims 2 and 15, amending claims 1, 5-10, 12-14, 17 and 18, and submitting arguments in support of the patentability of claims 1, 4-14 and 16-20.

In view of all of the above, the allowance of claims 1, 4-14 and 16-20 is respectfully requested.

Unless stated otherwise, any amendment to any claim was not made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, any amendment to any claim was made to simply make express what had been implicit in the claim as originally worded and therefore none of the amendments to the claims is a narrowing amendment that would create any type of prosecution history estoppel. In addition, to the extent that any formerly dependent claim is now presented in independent form, such an amendment does not constitute a narrowing amendment that surrenders any subject matter.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



Alan N. Herda  
Registration No. 50,426

Dated: 2/6/09  
HAYNES AND BOONE, LLP  
IP Section  
2323 Victory Avenue  
Suite 700  
Dallas, Texas 75219  
Telephone: 214/651-5924  
IP Facsimile: 214/200-0853  
D-1720104\_1.DOC